

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIEMENS MOBILITY, INC.,
GROUND TRANSPORTATION SYSTEMS USA INC.,
HUMATICS CORP., and PIPER NETWORKS, INC.,
Petitioner,

v.

METROM RAIL, LLC,
Patent Owner.

IPR2023-00460
Patent 10,737,709 B2

Before JAMES P. CALVE, HYUN J. JUNG, and NEIL T. POWELL,
Administrative Patent Judges.

CALVE, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. BACKGROUND

Siemens Mobility, Inc., Ground Transportation Systems USA Inc., Humatics Corp., and Piper Networks, Inc. (collectively, “Petitioner”) filed a petition requesting an *inter partes* review of claims 1–20 (the “challenged claims”) of U.S. Patent No. 10,737,709 B2 (“the ’709 patent”) (Ex. 1001). Paper 5, 1 (“Pet.”). Metrom Rail LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

We have authority to determine whether to institute *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2022) (“The Board institutes the trial on behalf of the Director.”). For the reasons discussed below, we do not institute an *inter partes* review.

A. *Related Proceedings*

The parties identify the following proceeding in which the ’709 patent has been asserted: *Metrom Rail, LLC v. Siemens Mobility, Inc.*, 22-cv-00049-RGA (D. Del. filed Jan. 13, 2022). Pet. iii (second occurrence); Paper 7, 3.

Patent Owner identifies the following IPRs that involve the same parties as this IPR: IPR2023-00439, IPR2023-00452, IPR2023-00468, and IPR2023-00470. Paper 7, 3.

B. *Real Parties in Interest*

Petitioner identifies Humatics Corp., Siemens Mobility, Inc., Ground Transportation Systems USA Inc., Piper Networks, Inc., and Thales USA, Inc. as the real parties in interest. Pet. iii (second occurrence).

Patent Owner identifies Metrom Rail, LLC as the sole real party in interest. Paper 7, 2.

C. The '709 patent (Ex. 1001)

The '709 patent is titled "WORKER PROTECTION SYSTEM." Ex. 1001, code (54). It issued from Application No. 16/246,940, filed on January 14, 2019, as a continuation of Application No. 15/078,427, filed on March 23, 2016. *Id.* at codes (21), (22), (45), (63), 1:5–11.

The '709 patent relates to enhanced worker protection systems and methods. Ex. 1001, 1:36–37. An exemplary worker protection system 100 comprises portable alert devices (PADs) 110, which are worn by workers and configured to communicate with one or more companion devices such as vehicle alert devices (VADs) 120 and wayside detection units (WDUs) 130. *Id.* at 2:37–65. VADs 120 are mounted on vehicles such as trains that pose a danger to workers working near tracks traveled by such trains and are configured to trigger and transmit alerts to PADs 110 when a VAD 120 detects it is approaching a work crew equipped with wearable PADs 110. *Id.* at 2:44–55. VADs 120 may alert a vehicle operator that workers are in proximity, display the number of detected workers, and indicate a distance to the workers. *Id.* at 2:55–60. Portable WDUs 130 are placed at worksites by workers to trigger alerts when WDUs detect an approaching train or vehicle. WDUs 130 may be used when no VADs 120 are being used or as redundant warning capability with VADs to provide additional range. *Id.* at 2:60–65.

D. Challenged Claims

Petitioner challenges claims 1–20 of the '709 patent, which are all of the claims issued with the '709 patent. Pet. 1, 3; Ex. 1001, 16:13–18:41 (the '709 patent claims 1–20). Claims 1, 12, and 20 are independent. Claims 2–11 depend from claim 1. Claims 13–19 depend from claim 12.

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–20 of the ’709 patent are unpatentable on the following three grounds (Pet. 1):

Ground	Challenged Claim(s)	35 U.S.C. §	Reference(s)
1	1–5, 7, 10–16, 19, 20	103 ¹	Meyer, ² Grisham ³
2	1–4, 6–12, 17–19	103	Cross, ⁴ Grisham
3	6, 8, 9, 17, 18	103	Meyer, Grisham, Cross

Petitioner asserts that each of the prior art references qualify as prior art under 35 U.S.C. § 102(a)(1) because their respective publication dates antedate the earliest March 23, 2015, priority date of the ’709 patent by more than one year. Pet. 1.

Petitioner also relies on a Declaration of Michael S. Braasch, Ph.D. Ex. 1003.

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), revised 35 U.S.C. § 103, effective March 16, 2013. Changes made to 35 U.S.C. § 103 in the AIA do not apply to any application for patent filed before March 16, 2013. Because the ’709 patent has an effective filing date after March 16, 2013, we refer to the AIA version of § 103.

² DE 10 2008 020 700 A1, published Nov. 5, 2009 (Ex. 1006, “Meyer-German”). Petitioner provides a certified English-language translation of Meyer-German (Ex. 1007, “Meyer”). *See also* Declaration of Harry Gigas (Ex. 1008) (certifying to the accuracy of the English-language translation of DE 10 2008 020 700 A1).

³ US 7,148,791 B2, issued Dec. 12, 2006 (Ex. 1009, “Grisham”).

⁴ WO 2013/056244 A1, published Apr. 18, 2013 (Ex. 1010, “Cross”).

II. ANALYSIS

A. *Parties' Contentions*

Petitioner contends that claims 1–5, 7, 10–16, 19, and 20 would have been obvious under 35 U.S.C. § 103 over Meyer and Grisham. Pet. 5–45. Petitioner contends that claims 1–4, 6–12, and 17–19 would have been obvious under 35 U.S.C. § 103 over Cross and Grisham. *Id.* at 45–73. Petitioner contends that claims 6, 8, 9, 17, and 18 would have been obvious under 35 U.S.C. § 103 over Meyer, Grisham, and Cross. *Id.* at 73–79.

Patent Owner asserts that it “strongly disagrees with Petitioners’ contentions as set out in the Petition, [but] Patent Owner has statutorily disclaimed claims 1–20 pursuant to 35 U.S.C. § 253(a).” Prelim. Resp. 1. Patent Owner contends that it effected a statutory disclaimer by submitting Form PTO/SB/43 (Disclaimer in Patent under 37 CFR 1.321(a)) on April 18, 2023, to the Office and as Exhibit 2001 in this proceeding. *Id.*

Patent Owner asserts, “because all challenged claims of the 709 patent have been disclaimed, the Petition to institute *inter partes* review of claims 1-20 of the 709 patent should be denied.” Prelim. Resp. 3.

B. *Patent Owner’s Statutory Disclaimer*

A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

35 U.S.C. § 253(a). When a disclaimer is recorded in the Office, “it shall thereafter be considered as part of the original patent.” *Id.*

In an *inter partes* review, if a patent owner files a statutory disclaimer that complies with § 1.321(a) and disclaims one or more claims in a patent, “[n]o *inter partes* review will be instituted based on disclaimed claims.”

37 C.F.R. § 42.107(e). A disclaimer must meet the following requirements:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee’s ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in § 1.20(d).

37 C.F.R. § 1.321(a).

Here, consistent with Patent Owner’s assertions, Office records reflect that Patent Owner filed a “Disclaimer in Patent Under 37 CFR 1.321(a)” on April 18, 2023 (“Disclaimer”). The Disclaimer is entered in this proceeding as Exhibit 2001. It is signed by “James Marchi, Chief Executive Officer” “Metrom Rail, LLC.” Ex. 2001. Mr. Marchi identifies “Patent Number 10,737,709” and states, “I hereby disclaim the following complete claims in the above identified patent: Claims 1–20.” *Id.* Mr. Marchi identifies his interest in the ’709 patent as “100% Patent Owner (Reel 047991/Frame 0943).” *Id.* The Disclaimer authorizes the Director to charge any required fees to Deposit Account No. 13-0017. *Id.*⁵

⁵ Mr. Marchi signed the Disclaimer at Lakemoor, Illinois on “April 2023.” The Disclaimer does not indicate the “day” on which Mr. Marchi signed it. However, Office records indicate that Patent Owner filed the Disclaimer electronically on April 18, 2023, and the Disclaimer was recorded in the Office in the ’709 patent electronic file wrapper on that date.

Based on our review of Exhibit 2001 and the Office’s public records,⁶ we find that Patent Owner properly disclaimed all claims of the ’709 patent, which are challenged claims 1–20 in this proceeding, and Patent Owner recorded the Disclaimer in the Office on April 18, 2023. The Disclaimer complies with the requirements of 37 C.F.R. § 1.321(a).

Because Patent Owner disclaimed all of the challenged claims in this proceeding, i.e., claims 1–20 of the ’709 patent, we may not institute an *inter partes* review of the ’709 patent. *See* 37 C.F.R. § 42.107(e); *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential).

III. ORDER

For the foregoing reasons, it is:

ORDERED that the Petition is *denied* as to all challenged claims of the ’709 patent and no trial is instituted.

⁶ An assignment by the named inventors of the ’709 patent of their interest in Application No. 15/078,427, filed March 23, 2016, for a Worker Protection System, and in any and all other applications filed on that invention, and in any and all patents obtained therefor, to “Metrom Rail, LLC” was recorded in the Office on January 14, 2019, at Reel 047991/Frame 0943 with a Patent Assignment Cover Sheet for Application No. 16/246,940, which was filed on January 14, 2019, as a continuation of Application No. 15/078,427. Application No. 16/246,940 issued as the ’709 patent on August 11, 2020. Ex. 1001, codes (10), (21), (22), (45), (63), 1:5–11.

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